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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/487,701	06/07/1995	JOE W. GRAY	028723-020	7971

21839 7590 07/09/2003

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EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631


DATE MAILED: 07/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No. <b>08/487,701</b>	Applicant(s) <b>Gray et al.</b>
Examiner <b>First Last</b>	Art Unit <b>1234</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 23, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 48, 49, 51-69, 71-73, 76-86, 88-93, and 95-104 is/are pending in the application.  
~~Claim(s) 1-47, 50, 70, 74, 75, 87, and 94 have been canceled. (Claims withdrawn from consideration)~~
- 5) ☒ Claim(s) 48, 49, 51-69, 71, and 98-101 is/are allowed.
- 6) ☒ Claim(s) 72, 76-86, 88-93, 95-97, and 102-104 is/are rejected.
- 7) ☒ Claim(s) 73 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☒ Other: Attachment for PTO-948

In view of the appeal brief, filed 5/23/01, and newly found rejections summarized herein, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

file a reply under 37 CFR 1.111; or  
request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131, or 1.132) or other evidence are permitted. See 37 CFR 1.93(b)(2).

Applicants' arguments, filed 5/23/01, have been fully considered and they have overcome the rejections under 35 U.S.C. § 112 and 103(a), but they are not persuasive regarding certain double patenting rejections as summarized below. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### **PRIORITY**

If applicant desires priority under 35 U.S.C. § 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. It is noted that this appears as the first sentence

of the specification following the title. The status of non-provisional application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

#### **DRAWINGS**

Figures 13A-13I, 14, 15A, 15B, 16A, 16B, 17A, 17B, 18A, 18B, 19A, 19B, 20, and 21 have been submitted in color. Applicants must either cancel the drawings, provide substitute black and white drawings, or file an acceptable Petition to accept color drawings.

Applicants may file a petition under 37 CFR 1.84(a) with fee requesting acceptance of the color drawings including three sets of color drawings and the appropriate amendment to the specification as set forth in 37 CFR 1.84(a). Only if the petition is granted will the draftsman be authorized to review and potentially approve the color drawings as to form.

Where color drawings have been transferred from a prior application to a newly submitted application, applicants must renew the petition under 37 CFR 1.84(a) even though a similar petition was filed in the prior application. Until the renewed petition is granted, the examiner must object to the color

drawings as improper. See MPEP 608.02.

Applicants are also hereby notified that the required timing for the correction of drawing informalities has changed. See the last 6 lines on the sheet which is attached entitled "Attachment for PTO-948 (Rev. 03/01 or earlier)". Due to the above notification Applicants are required to submit drawing corrections within the time period set for responding to this Office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

#### DOUBLE-PATENTING

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 72, 76-86, 88-93, 95-97, and 102-104 are rejected under the judicially created doctrine of obviousness-type double

patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,344,315. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to methods of staining utilizing unique sequence high complexity probes. The instant claims include any chromosome whereas the specific chromosomes of said Patent claims are clearly species therein. The various abnormalities of the instant claims are also extremely well known chromosomal abnormalities that are assessed by hybridization assay. Lastly the complexity is high in both sets of claims and clearly overlap regarding complexity of probe practice. This rejection is maintained and reiterated from the previous office action, mailed 4/17/00, but now applied to corresponding Patented claims originally from application serial number 08/477,316.

Claims 72, 76-86, 88-93, 95-97, and 102-104 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,500,612. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to methods of staining utilizing unique sequence high complexity probes. The instant claims include any chromosome whereas the specific chromosome 21 of said Patent is clearly a specie therein. The various abnormalities of the instant claims are also extremely well known

chromosomal abnormalities that are assessed by hybridization assay. Lastly the complexity is inclusive of high complexity in both sets of claims and clearly overlap regarding complexity of probe practice. This rejection is maintained and reiterated from the previous office action, mailed 4/17/00, but now applied to corresponding Patented claims originally from application serial number 08/472,312.

Claims 72, 76-86, 88-93, 95-97, and 102-104 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 9, 10, 13-16, 19-29, and 31 of U.S. Paten No. 6,280,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to methods of staining utilizing unique sequence high complexity probes. The instant claims include any chromosome whereas the specific fluorescent labeling of said Patent are clearly species therein. The various abnormalities of the instant claims are also extremely well known chromosomal abnormalities that are assessed by hybridization assay. Lastly the complexity is high in both sets of claims and clearly overlap regarding complexity of probe practice. This rejection is maintained and reiterated from the previous office action, mailed 4/17/00, but now applied to corresponding Patented claims originally from application serial number 08/487,974.

Claim 73 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 48, 49, 51-69, 71, and 98-101 are allowed.

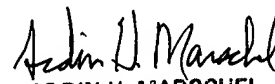
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

July 7, 2003

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER